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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/387,443      | 09/01/1999  | WILLIAM KOPACIEWICZ  | 550P002CONT.        | 2583             |

7590 04/07/2004

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WESTBORO, MA 01581

EXAMINER

FORTUNA, ANA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1723

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/387,443

Applicant(s)

KOPACIEWICZ, WILLIAM

Examiner

Ana M Fortuna

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/03</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6, 9, 11, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipate by Fuller (3,878,092). Fuller discloses the housing or chromatographic column comprising sorptive particles bound to a polymer and chemically adhered or bound, e.g. covalently bound to the inner wall of the housing (Figure 3, elements 20, 24, 23, column 7, lines 25-68, column 2, lines 37-64). As to claims 6 and 16, reacted styrene monomer is disclosed as the bound polymer (column 4, lines 46-51). Regarding claim 9, silica is disclosed as suitable packing materials or adsorbent particles materials (column 9, lines 37-43).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hjerten et al (5,645,717)(hereinafter '717). Reference '717 discloses a housing, e.g. chromatographic column or pipette, comprising and adsorptive polymer (e.g. polymer having adsorptive properties) adhered to the interior walls of the housing or pipette (abstract, column 1, lines 25-68, column 2, lines 1-25, column 5, last paragraph bridging column 5, lines 1-35, and column 7, lines 18-21). As to claim 12, forming the adsorptive polymer at the end and on a support disposed at the end of the column is disclosed in '717 (column 5, second paragraph). Regarding claims 13-14, the volume of polymer disposed in the pipette or column is disclosed as 1 mL (column 7, lines 19-34). As to claim 15, the claimed configuration is inherent of the pipette tips.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-9, 11, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nochumson et al (5,552,325) in view of applicant's admissions.

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Reference "325 discussed in the record, does not teach the chemical bonding to the inner wall of the housing. Applicant admits that bonding the structure to the housing by chemical bonding is known to those skilled in the art (page 9, last paragraph through page 10, first paragraph). It would have been therefore, obvious to one skilled in the art at the time the invention was made chemically react the polymer with the surface of the column to fix the membrane or adsorptive structure in place within the housing or pipette.

6. Claims 1, 2, 3, 4, 11, 12, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (5,156,811), in view of Applicant's admissions. White fails to disclose chemical bonding. Applicant admits that the chemical bonding between the housing and polymeric structure is known in the art, therefore, selecting attachment of the membrane to the inner wall of the housing by conventional methods, including chemical attachment, it would have been obvious to one skilled in the art at the time the invention was made.

7. Claims 3, 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nochulson et al in view of Applicant's admission, as discussed above and further in view of Hagen et al or Hilderbrandt et al. the combination of references is discussed in the record. Applicant admissions provide teaching of chemically bonding the polymer to the inner wall of the housing, as discussed above.

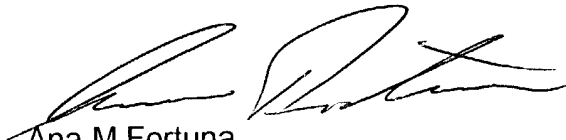
***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference 3,797,202 teaches bonding membrane areas by chemical bonding.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M Fortuna whose telephone number is (571) 272-1141. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ana M Fortuna  
Primary Examiner  
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AMF

April 03, 2004